



1636  
ATTY. DOCKET NO. P67431US0

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of: FORSSMANN et al.

Serial No.: 09/926,820

Group Art Unit: 1636

Filed: December 26, 2001

Examiner: Q. NGUYEN

For: SERINE PROTEASE INHIBITORS

TRANSMITTAL

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Transmitted herewith please find:

- ☒ Response to Restriction Requirement
- ☐ Petition for extension of time
- ☐ Fee payment ☐ Payment Form PTO-2038 (credit card) for \$ \* is attached.
- ☐ Charge \$ \* to Deposit Account No. 06-1358.
- ☐ Small entity status established in connection with the subject application.

Fee Calculation					
Excess Claims					
	Nº of Claims	Highest Nº Paid For	Excess Claims	Small Entity Fee	Large Entity Fee
Total	*	⊖ * =	0	⊗ \$9 = \$	⊗ \$18 = \$
Ind.	*	⊖ * =	0	⊗ \$43 = \$	⊗ \$86 = \$
( ) Multiple Dependent Claims (1 <sup>st</sup> Filing)				⊕ \$145 =	⊕ \$290 = \$
Extension of Time Fee				\$	\$
Total Fee Due				??	??

- ☒ If a petition for extension of time is necessary, but not enclosed, then this acts as the petition. Charge any fees additionally necessary in connection herewith to Deposit Account No. 06-1358.

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Date: April 26, 2004  
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By

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Registration No. 31,409



Attorney Docket No. P67431US0

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**RESPONSE  
TO RESTRICTION REQUIREMENT**

Commissioner of Patents  
Box 1450  
Alexandria, VA 22313-1450

Sir:

This paper responds to the Office Action (restriction requirement) mailed March 24, 2004.

Pursuant to the restriction requirement under 35 USC 121 and 372, for alleged lack of unity of invention under PCT Rule 13.1, election is made, hereby, to prosecute invention Group I, claims 15-20, with traverse. Traverse is maintained because the present claims satisfy the requirements for unity of invention under PCT Rules.

The Office Action (page 5) recognizes the requisite technical feature linking Groups I to XXII, i.e., the serine protease inhibitor having the amino acid sequence according to SEQ ID NO: 1 or its fragments, for satisfying PCT Rule 13.1. Allegedly, this linking technical feature is not novel in view of the EMBL DATABASES Accession no. AJ228139 (XP2131458).

First of all, neither March 10, 1998, nor April 6, 1999, is the effective date of the reference relied on to sustain the allegation that the shared "special technical feature" lacks novelty. The dates at issue in connection with the reference are "13-JUL-1998" and "03-AUG-1999"; the former being

the date of the reference as originally published, which is not of record, and the latter being the date the original publication was "Last updated." In other words, **August 3, 1999**, is the effective date of the reference as relied on to support the restriction, because it has not been shown that the disclosure relied on in the reference, i.e., "the same amino acid sequence of SEQ ID NO: 1" (Office Action, page 5), was part of the document "Created" on July 13, 1998. It must be remembered that the initial burden of demonstrating the effective date of a reference falls on the PTO. *Ex parte Natale*, 11 USPQ2d 1222, 1226 (BPA&I 1989).

While the effective date of the cited reference is August 3, 1999, the filing date of the subject §371 application is June 22, 1999, the filing date of the international application. 35 USC 365. Since the filing date of subject application antedates the effective date of the cited reference, the reference can not be used to show lack of unity of invention under PCT Rule 13.1.

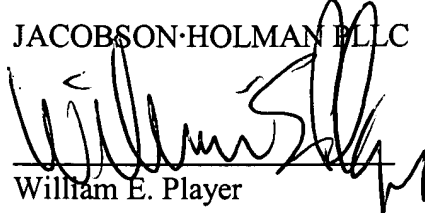
Secondly, XP2131458 was authored by a named co-inventor of the subject application – H.J. Mägert. As such, the cited reference cannot be considered when determining unity of invention under PCT Rule 13.1.

Favorable action is requested.

Respectfully submitted,

JACOBSON-HOLMAN PLLC

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